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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,732	03/29/2001	Yousuke Tanaka	0397-0424P	4354

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EXAMINER

CAMPBELL, THOR S

ART UNIT PAPER NUMBER

3742

DATE MAILED: 10/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,732

Applicant(s)

TANAKA, YOUSUKE

Examiner

Thor S. Campbell

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-12, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) 13-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Heidt et al. (US 5336467).

Heidt discloses a chemical analyzer including a metering pump connected to a disposable pipette for dispensing a sample of biological fluid to be tested, a drive mechanism for moving the metering pump and pipette, further wherein the metering pump is driven by a stepper motor to advance a piston in a cylinder.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt in view of JP 2-080937A.

Heidt disclose the claimed invention except the cleaning fluid channel extending from the outer circumference of the cylinder. JP 2080937A discloses a pipette dispensing device having a radially extending passage for flowing cleaning fluid therethrough. It would have been

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obvious to one of ordinary skill in the art to modify the device of Heidt to include a passageway for flowing a cleaning fluid through the dispensing device in order to eliminate contamination from one sample to the next.

Claims 9-11, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt in view of JP 09133686A.

Heidt disclose the claimed invention except a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. JP 09133686A discloses a pipette dispensing device having a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. It would have been obvious to one of ordinary skill in the art to modify the device of Heidt to include a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit in order to provide an accurate sample volume.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt in view of JP 09133686A and Kogo et al (US 4891575).

Heidt disclose the claimed invention except a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit, and the analyzing section that counts the pulses due to a change in electrical impedance. JP 09133686A discloses a pipette dispensing device having a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. Kogo discloses a particle detection system using an aperture and a current to count the pulses of impedance due to a presence or absence of cells in the circuit. It would have been obvious to one of ordinary skill in the art to modify the device of Heidt to include a liquid surface detection circuit that senses the contact

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with the sample surface by the change in capacity of the circuit in order to provide an accurate sample volume and a analyzing section as described by Kogo in order to provide an accurate count of the red or white blood cells in a sample.

Allowable Subject Matter

Claims 13-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Machida et al., Kacerek, Fullemann, Klein, Yamamoto et al., and Tersteeg et al. disclose states of the art relevant to applicants invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thor S. Campbell whose telephone number is 703-306-9042. The examiner can normally be reached on Tue-Fri 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3463 for regular communications and 703-305-3463 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

A handwritten signature in black ink, appearing to read 'Thor S. Campbell', is located at the bottom right of the page.

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Thor Campbell
Patent Examiner
AU 3742

TSC
October 28, 2002